

REMARKS

Reconsideration of this application is respectfully requested.

This application has been reviewed in light of the Office Action dated March 1, 2005 and the Advisory Action dated June 20, 2005. Claims 1-16 are currently pending in the application. Claims 1 and 14 have been amended. Support for these amendments is provided, for example, at paragraph 0003 of the application. Claims 15-17 have been added. Adequate support for Claims 15 and 16 are disclosed in at least paragraphs 0036-0037, 0069 and 0139-0141 and support for Claim 17 is disclosed in at least paragraphs 0002, 0073 and 0139-0140. Therefore, it is respectfully submitted no new matter has been added with the addition of Claims 15-17.

Claims 1-14 were rejected for the reasons set forth in the Office Action dated March 1, 2005 on pages 2-10.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (U.S. Patent No. 6,629,092) in view of Coakley (US-2002/019416). The Examiner asserted "Berke teaches a process for registering a trademark by means of a local computer (Fig. 2:4) connected to a remote computer (Fig. 2: 8) via computer Internet network (Fig. 2:6)(column 4, lines 58-65) performing the following steps in order: entering the trademark (columns 3 & 4, 30-32 & 15-19); selecting the products or 'goods' to which the trademark applies (column 3, lines 30-32); validating the entry and selection (column 3, lines 32-36); sending (storing) the validated entry and selection to the remote computer (column 3, lines 36-38) via the network (column 3, lines 19-25)". The Examiner states "Berke does not specifically teach wherein the selecting of products or 'goods' was from at least one official class of products and services". The Examiner then asserted "[i]t would

have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have used a[n] official class of products and services, because Coakley teaches using the official class was an internationally recognized standard for classing products and services of a trademark (Page 2:Paragraph 0015) and would be an ‘accurate’ database as described in Berke (column 6, lines 52-57”).

Berke is directed to a search engine system, server and method for providing a user with information related to a particular company or entity. Berke enables a user of the search engine to enter a known trademark and associated goods and/or services of the trademark and returns to the user specific information related to the owner of the known trademark, instead of returning a plurality of ‘hits’ as with conventional search engines. The returned specific information may be the trademark owner’s website, a constructed website for the trademark owner or a list of authorized vendors for the products and/or services of the trademark owner. Furthermore, the search engine system of Berke allows a trademark owner to “register” the trademark and its associated goods with the search engine as to add a record in the database of the search engine; not to prepare an application for registering a mark with a competent administrative department, for example, an appropriate national agency such as the French Patent Office or the U.S. Patent and Trademark Office.

Coakley is directed to a trademark brokerage system for facilitating the brokering of trademarks between trademark owners and potential trademark buyers. A potential trademark buyer using the system of Coakley will enter a search request consisting of a description of the desired goods or services or a particular trademark

classification. If any trademarks within the trademark brokerage database satisfy the search request, the buyer will be presented with a list of trademarks available for sale.

Claim 1 of the instant application is directed to a process “for preparing a trademark registration application to file at a competent administrative department responsible for examining the application” including the steps of, *inter alia*, “(i) entering the trademark to be filed at the competent administrative department, [and] (ii) selecting the products or services from at least one official class of products and services to which the trademark applies”. The process of Claim 1 facilitates the preparation of a trademark application by allowing a user to select products or services from known official classes of products and services. By enabling a user to select products or services from known official classes, the products and services enumerated by the process of Claim 1 should be accepted by the administrative departments, e.g., corresponding trademark offices, responsible for examining the trademark applications with a view to nationally or internationally registering the trademark in the application (see instant application paragraphs 0008-0013, 0028 and 0059).

As mentioned above, Berke is a search engine that uses a trademark to access the website of the trademark owner or to locate a vendor for the trademarked product. The primary purpose of Berke’s search engine is to reduce the number of hits generated in response to a query. To accomplish this, Berke associates specific words to the trademark. This would be helpful for a common trademark, e.g., ACME. The additional input of food store could direct the user to the website for the ACME food supermarkets. By following the Examiner’s suggestion of using an official class of products and services as taught by Coakley, the description associated with the trademark would become overly

broad and will likely increase the number of hits generated in response to a query, thereby defeating the purpose of the search engine. Furthermore, the Examiner implied using the official class of products and services would be an accurate database as described in Berke (column 6, lines 52-57). Upon a closer reading of Berke, Berke does not suggest “an official class” would be an accurate database but suggests using Federally registered trademarks could be used to populate the database of Berke’s search engine. Owners of the trademark could register with Berke and at the time of registration could choose the goods they wanted the Berke users to associate with their mark. These goods are likely to be very different from terms acceptable to a trademark office. A company registering with Berke would not want to associate its trademark with a description of goods established by a government agency, e.g., competent administrative department, for the purposes of registering trademarks with that agency.

Furthermore, neither the search engine of Berke nor the brokerage system of Coakley have anything to do with the preparation of a trademark registration application “to be filed at a competent administrative department responsible for examining the application” as recited in Claim 1. A skilled artisan would not be motivated to combine these references to create a process for facilitating the preparation of a trademark registration application which would most likely be accepted by the administrative departments responsible for examining the trademark applications. Therefore, it is respectfully submitted that Claim 1, along with dependent claims 2-13 and 15-16, are patentably distinct and not rendered obvious over Berke and Coakley.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (U.S. Patent No. 6,629,092) in view of Coakley (US-2002/019416). The Examiner

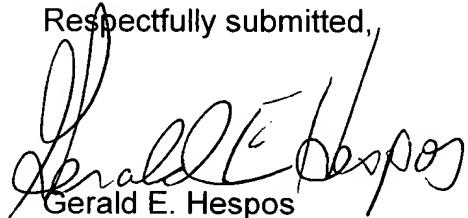
uses Berke for the same reasons as stated above in relation to Claim 1. The Examiner then asserted "Coakley teaches comparing said freely chosen wording with potential wordings contained in a file of at least one official class (Page 4:Paragraphs 0039-0040); displaying proposed wordings from among the potential wordings (Page 4:Paragraphs 0039-0040); selecting at least one wording from among the proposed wordings (Page 4:Paragraphs 0039-0040); displaying a number of the official class corresponding to the wordings selected (Page 4:Paragraphs 0039-0040) (Fig. 3b:179). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have utilized the above features of Coakley, because Coakley teaches that said steps would provide the benefits of better locating trademarks (Page 4: paragraph 0040) which would allow the trademark registration of Berke to better classify said trademark' goods and services".

The brokerage system of Coakley includes an interrelated classifications table where if a user enters a description for a mark, the system will present several different classifications for the user to search for an available trademark for sale. The user may then select the additional classes to be search; this search is done for the entire class not proposed or alternative wordings. By adding this feature to the search engine of Berke, a user registering a trademark in the search engine of Berke will simply associate one or more classes to the mark and likely increase the number of hits generated by users of the search engine. Furthermore, the combination of Berke and Coakley does not teach the process for preparing a trademark registration application "to be filed at a competent administrative department responsible for examining the application" of Claim 14 including, inter alia, "entering the trademark to be filed at the competent administrative department,"

and "selecting at least one wording from among the proposed words". Therefore, it is respectfully submitted that Claim 14 is patentably distinct and not rendered obvious over Berke and Coakley.

In view of the preceding remarks, it is respectfully submitted that all pending claims, namely claims 1-17 are in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,



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